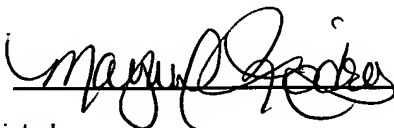


PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

6674P001

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on December 9, 2005.

Signature 

Typed or printed name Margaux Rodriguez

Application No.

10/674,443

Filed

September 29, 2003

First Named Inventor

Richard A. Falcioni

Art Unit

2672

Examiner

Wang, Jin Cheng

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

NOTE: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under of 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ Attorney or agent of record.
Registration Number 42,261
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Farzad E. Amini

Typed or printed name

(310) 207-3800

Telephone Number

December 09, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required.

☒ *Total of 1 forms are submitted.



Attorney's Docket No.: 006674.P001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Richard A. Falcioni

Serial No.: 10/674,443

Filed: September 29, 2003

For: GENERATING ALPHANUMERIC
CHARACTERS

Examiner: Wang, Jin Cheng

Art Group: 2672

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant is filing this request to demonstrate a clear legal and factual deficiency in the rejections made in a Final Office Action dated July 27, 2005.

The rejections in the Final Office Action were also discussed with Examiner Wang during a telephonic interview on October 21, 2005, at which the undersigned and the Applicant were in attendance. The language of claims 1 and 21 were discussed in view of the rejections, and in particular the limitation of "a plurality of features of a respective one of the characters."

Claims 1-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2004/0239624 A1 issued to Ramian ("Ramian"). In essence, the rejection states that Applicant's claimed invention has reversed the parts of Ramian's components and, therefore, is obvious over Ramian, citing *In re Gazda*, 104 USPQ 400, 402; 219 F.2d 449 (CCPA 1955). See the Final Office Action, page 3, first paragraph. Such a modification to Ramian would allegedly have been required "for constructing an alternative way for generating alphanumeric characters and thereby suggesting the obvious modification of Ramian." [Final Office Action, page 4, second paragraph] The rejection is flawed for the following reasons.

Considering Applicant's claim 1, a method for generating a desired alphanumeric character is recited where a user's selection of a combination of one or more zones, taken from a

plurality of zones, is received. These plurality of zones abut one another, eliminating intervening spaces. The selected combination is contrasted with the remainder of the zones, so that the combination is essentially removed leaving behind a graphic symbol that resembles the desired character. As an example, consider Fig. 5 of Applicant's Specification. There, a matrix 408 of regions or zones is depicted, from which regions 532 and 546 have been selected by the user (Fig. 5 actually contains an error in that the reference number 546 is called out twice; the central, lower region should have the correct reference number 532 instead).

Selected regions 532, 546 are contrasted with the remainder regions of the matrix, so that a graphic symbol is formed by the remainder regions that bears a strong resemblance to the letter "b". This same matrix may be used to depict all twenty-six characters of the English alphabet as shown in Fig. 7, where the selected zones are the large, white rectangles and the unselected or remainder are the large, black rectangles.

Turning now to Ramian, a freehand symbolic input apparatus is described that allows the user to bring an implement into contact with an input surface and then move the implement across the input surface along straight or curved lines or paths (forming a trace path). The trace path is stored in a database, through a training phase, where the user can "teach" the apparatus preferred valid inputs and their associated symbols. Ramian does state that the user is not required to associate traditionally shaped traces, with characters which are emitted to a display device. According to Ramian, any continuous trace path can be associated with any character or symbol known to the user, which can be represented by the traces. However, the only examples given in Ramian for mapping a character to a valid input trace are what is shown in Fig. 2.

In Fig. 2, the selected curve for the letter "a", for example, is illuminated at reference 520. This is difficult to tell from the black and white print of the patent publication, so a highlighted version is attached here. It is the selected (highlighted) group of curves and traces that resemble the desired character, not the remainder of the input surface. There is also no teaching or suggestion in Ramian that the *remainder* (which in Ramian may arguably be the non-illuminated portions of the input surface) be used as the user's selection to indicate the desired character. Only with impermissible hindsight can such a modification be made to Ramian.

According to the rejection, Applicant's claimed invention is an obvious reversal of Ramian, citing *In re Gazda* in support. The facts of this case are, however, quite different than those of *In re Gazda*. There, the Applicant's claimed invention is a wind-up clock for use in an automobile. The prior art disclosed a clock that is fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with the steering wheel (turning the steering wheel thus winds up the clock). The applicant's invention in that case mounted the

clock to the steering wheel instead, and the winding occurred through a wind-up mechanism that was fixed to the steering column. According to the Examiner in that case, whether the clock is mounted on the steering wheel or on the steering column, is only a matter of choice amounting to a mere reversal of parts.

In that case, however, there was a clear suggestion in the prior art cited by the Examiner, that taught a rotatable mounting for a clock, where its winding was effected by movement of the clock parts relative to a stationary member. 104 USPQ, 400, 402[1]. There was also a teaching in the prior art that the applicant's claimed wind-up mechanism was the mechanical equivalent of a known gear and ratchet 194 USPQ, 400, 402[2]. Accordingly, the rejection that was upheld in *In re Gazda* was not based on knowledge that was derived and applied from the applicant's disclosure, but instead was based on a clear teaching found in the cited prior art. That is not the situation here.

The rejection in this case provides no proper explanation as to why one of ordinary skill in the art would consider that Ramian's remainder be used as the user's input, to select or indicate the desired character to be entered. The Final Office Action at page 4 merely concludes that the modification to Ramian would have been "required for constructing an alternative way for generating alphanumeric characters." That is an improper basis for finding that one of ordinary skill in the art would have been motivated to modify a reference.

In Ramian the valid inputs are only trace paths that positively define a feature of the character. See, for example, Fig. 2, reference 500 where the highlighted trace for character "M" consists only of the actual features of upside down hooks "↑" and "↑" which together form "M". The same goes for the other characters shown, namely, reference 524 for "a", reference 530 for "C", reference 540 for "π", and reference 550 for "z". Ramian also suggests that a user skilled in the art of shorthand would be open to the suggestion that the input of a single trace could result in the output of many characters. For example, the basic shape of a house being drawn could be trained to output the text "house" or "home". In all of these instances, however, Ramian is clearly requiring the user to indicate a trace path that itself resembles the desired character. Any alternatives that may be suggested by Ramian are therefore along the same lines, namely that the user input can only be a positive feature of the desired character.

The mere "reversal" argument in the rejection also fails to convince, because of an important benefit of generating user inputted characters in the manner required by Applicant's claims. Applicant's so-called "complementary" approach to enter characters selected by a user is believed to be more efficient as the number of strokes required are significantly less than if the user were to trace the outline (ore even a part of the outline) of each character. The Applicant has determined that the relationship between certain aspects of the complement of a character


and the positive features of the character can help the user remember which complementary zones or regions are to be selected for entering a desired character. For example, in the case of the letter "b", the user can quickly learn that "b" is indicated by selecting the appropriate zones 532, 546 shown in Fig. 5, since the user will remember that those zones roughly correspond to the "empty" spaces in the central, lower part and the upper right hand corner of the letter "b". The user will thus train herself to think in terms of the empty spaces for each character, when recalling the character's traced outline or positive features, making the claimed character generation process easier to learn.

In view of the foregoing, Applicant submits that not only is his claimed invention not a "mere reversal" of Ramian, but also that the rejection does not properly make the case for its obviousness.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: December 9, 2005

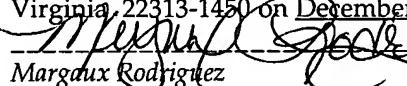
By


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Margaux Rodriguez

December 9, 2005